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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,307	04/09/2004	Raymond Lynn Goodson	15999.5	9695

22913 7590 05/05/2005

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(F/K/A WORKMAN NYDEGGER & SEELEY)  
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EXAMINER
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XU, LING X

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/821,307

**Applicant(s)**

GOODSON ET AL.

**Examiner**

Ling X. Xu

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 13-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/9/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12 and 34-37, drawn to a decorative laminate panel, classified in class 428, subclass 130.
  - II. Claims 13-33, drawn to a method, classified in class 156, subclass 309.6.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process can be used to make other and materially different product such as the laminate comprising metallic wires sandwiched between the two extruded sheets.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Michael Frodsham on 4/11/2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12 and 34-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5, 8-12, 34 and 37 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29, 33-35 and 37-45 of copending Application No. 10/465,465. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the copending application recite the same decorative laminate structure comprising a first and second sheet of polycarbonate having thickness in the same range as claimed in the present application. The decorative laminate structure recited in the copending application also comprises a decorative image layer between the first and second sheet, which may be compressible objects such as

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vegetation, wood chips, grasses, thatch flowers, etc. Since the claims in the copending application disclosed the same polymer material as claimed in the present application, the same material would also have the same critical pressure as recited in claims 10-12 and 34.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 4, 6-7 and 35-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29, 33-35 and 37-45 of copending Application No. 10/465,465 in view of Eckart et al. (US 5,958,539).

As stated above, claims in the copending application recite the same decorative laminate structure comprising a first and second sheet of polycarbonate having thickness in the same range as claimed in the present application. The decorative laminate structure recited in the copending application also comprises a decorative image layer between the first and second sheet, which may be compressible objects such as vegetation, wood chips, grasses, thatch flowers, etc.

Although claims in the copending application do not recite the use of PETG material, however, using of PETG material as the polymeric material for decorative laminate is known in the art. Eckart teaches a decorative laminate comprising in order, an upper sheet of material, a fabric comprising of textile fibers, and a lower sheet material (abstract). Both upper and lower sheet comprises PETG copolyester (col. 6, lines 1-10). Therefore, it would have been obvious to one of ordinary skill in the art to use PETG as the sheet material because it is a thermoplastic

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material and is highly suitable for the lamination process of making the decorative laminate structure, as taught by Eckart (col. 6, lines 1-10).

This is a provisional obviousness-type double patenting rejection.

### ***Claim Objections***

4. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 2 recites that the extruded sheets is one of transparent, translucent, and opaque material, which encompass all the possible choices that the appearance of the extruded sheets. Claim 2 does not further limit the extruded sheet of claim 1 since the extruded sheets recited in claim 1 can be any one of the possible choices of transparent, translucent or opaque material.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 and 34-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, it recites that the extruded sheets is one of transparent, translucent, and opaque material, which encompass all the possible choices that the appearance of the extruded sheets. It

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is unclear if there are any appearances of the extruded sheets other than the transparent, translucent or opaque material.

The claim subject matter in claim 1 is a decorative laminate panel comprising the compressible objects, which has not changed substantially when the extruded sheets are formed together. Claims 10-12, however, recite that the one or more compressible objects substantially deform and are viewed as having an unnatural appearance. Claims 10-12 depend on claim 1 but recite deformed compressible objects, which is different subject matter from what was recited in claim 1.

In claim 36, it is unclear if the “first and second extruded sheets extruded PETG sheets” should be -- first and second extruded sheets are extruded PETG sheets --.

In claim 37, it is unclear if the “first and second extruded sheets extruded polycarbonate” should be -- first and second extruded sheets are extruded polycarbonate sheets --.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-3, 5-6, 8-12, 34-35 and 37 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by Schober (US 2003/0113485).

With respect to claims 1-2 and 34, Schober discloses basic lay-up sandwich comprising two non-porous polymeric sheets and a visible decorative object sandwiched between the polymeric sheets (embodiments [0023] and [0032]).

With respect to claims 3, 5 and 37, Schober discloses the polymeric sheets may be polycarbonate and have thickness from about 0.004-1.0 inch (embodiments [0024]).

With respect to claim 6, Schober discloses the polymeric sheet is 48 inches wide and 96 inches long (embodiment [0049]), which is within the range as claimed.

With respect to claim 8, Schober discloses that the visible decorative object may be made of varied natural materials such as plant leaves, tree bark and twigs (embodiment [0032]), which is the same compressible objects as claimed.

With respect to claim 9, Schober discloses that no bubbles or voids are entrapped in the sandwich structure (embodiment [0041]).

With respect to claims 10-12 and 34, Schober discloses that the same compressible objects as claimed and therefore, it would also be deformed at a critical pressure as recited. However, the lay-up sandwich structure has the same appearance as the claimed panel before the pressing process.

With respect to claim 35, Schober discloses a pressure pad positioned about on the first or second extruded sheets (embodiment, [0047]).



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7. Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Eckart et al (US 5,958,539).

Eckart discloses laminate comprising in order, an upper sheet of material, a fabric comprising of textile fibers, and a lower sheet material (abstract). Both upper and lower sheet comprises PETG copolyester (col. 6, lines 1-10). The textile fibers are compressible material, which will not change substantially when the upper and lower sheets are formed together. The laminate may be transparent, translucent, or opaque.

Since Eckart discloses the same polymeric material for the upper and lower sheets, the same material would also have the same properties as recited in claim 7.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6, 8-12 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckart et al., as applied to claims 1-2 and 7 above, and further in view of Schober.

As stated above, Eckart discloses laminate comprising in order, an upper sheet of material, a fabric comprising of textile fibers, and a lower sheet material (abstract). Both upper and lower sheet comprises PETG copolyester (col. 6, lines 1-10).

Eckart does not disclose that the laminate comprising the structure as recited in claims 3-6, 8-12 and 34-37.

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Schober teaches the basic lay-up sandwich comprising two non-porous polymeric sheets and a visible decorative object sandwiched between the polymeric sheets (embodiments [0023] and [0032]). The decorative object may be made of varied natural materials, plant leaves, tree bark and twigs (embodiment [0032]). Since Schober discloses that the same compressible objects as claimed and therefore, it would also be deformed at a critical pressure as recited. However, the lay-up sandwich structure has the same appearance as the claimed panel before the pressing process.

Schober also teaches that no bubbles or voids are entrapped in the sandwich structure (embodiment [0041]) and a pressure pad positioned about on the first or second extruded sheets (embodiment, [0047]).

Therefore, it would have been obvious to one of ordinary skill in the art to use the laminate structures taught by Schober including the natural materials such as plant leaves, tree bark and twigs as the decorative objects in order to achieve unusual visual decoration effects, as taught by Schober (embodiment [0002]).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling X. Xu whose telephone number is 571-272-1546. The examiner can normally be reached on 8:00 - 4:30 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah D. Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ling X. Xu  
Examiner  
Art Unit 1775

lx